

same force 8 acting on the [center of mass 6 of the] club head 2 also produces a moment 10, which tends to rotate the club head in the plane of the swing in a counterclockwise direction (when viewed from a position opposite the golfer), thereby increasing the effective loft angle of the club head at impact with golf ball 12."

In the Claims

3. (Amended) The golf club shaft of claim 1, wherein:

[said butt end has an outside diameter of from .520 to .540 inches.] a length of the shaft is from about 35-47 inches.

REMARKS

Re-examination of the above-identified application is respectfully requested.

With respect to the drawings objection, Applicants have amended page 4, lines 14-22 of the specification to more particularly reflect the intended use of the reference character 6. Accordingly, withdrawal of the objection is respectfully requested.

Similarly, the disclosure on page 4 has been amended to more specifically identify the different moments acting on club head 2, not specifically the center of mass 6. Therefore, the clarification addresses the Examiner's Item 3 wherein the question is raised regarding the moments 6 and 8 extending about a point intersected by a force. Accordingly, withdrawal of the objection is respectfully requested.

Claim 3 is rejected under 35 U.S.C. §112. Applicants deleted the portion of the claim which was objected to and substituted therefore the limitation concerning the length of the shaft (see page 8, line 5 for support). Applicants submit that this amendment should be entered in view of the following arguments wherein it is

established that the invention is patentable over the prior art of record and will lead to allowance. Nonetheless, even if the amended claim 3 is not entered, the claimed invention is still patentable as articulated below.

Claims 1-3 are rejected under 35 U.S.C. §103(a) as being unpatentable over Akatsuka (5,437,450). Claims 5, 7-9, 11, 13-20 are rejected under 35 U.S.C. §103 as being unpatentable over Akatsuka and further in view of Hogan. Claim 6 is rejected under 35 U.S.C. §103 as being unpatentable over Akatsuka and further in view of Hogan and Akatsuka (5,156,396). Claim 12 is rejected under 35 U.S.C. 103 as being unpatentable over Akatsuka (5,437,450) in view of Hogan and further in view of Akatsuka (5,156,396). Applicants respectfully traverse.

At the outset, Applicants note that each rejection is based on the primary finding of the Examiner with respect to claims 1-3 that the invention is unpatentable over Akatsuka. Particularly, according to the Examiner, Akatsuka discloses a shaft of the presently claimed invention as described with the exception of the butt end diameter. The Examiner concludes that "Clearly an artisan skilled in the art of making a shaft with the right length and butt size to fit players with smaller hands and shorter heights, as for example children, would have selected a suitable butt end outside diameter in which a diameter of about .460 inches is included".

Applicants respectfully challenge this conclusion by the Examiner. First, Applicants respectfully request that the Examiner provide a prior art document evidencing a butt size of a shaft, sized to fit players with smaller hands, such as children and most importantly, a butt end diameter which would include a diameter of .460 inches. Without such a document, the Examiner cannot merely make the above conclusion and issue a final rejection.


In fact, as established In re Warner et al., 154 U.S.P.Q. 173 (CCPA 1967), the burden is on the Patent and Trademark Office to establish a prima facie case of obviousness. The mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability which forces an Applicant to prove conclusively that the Patent Office is wrong. In re Soli, 137 U.S.P.Q. 797 (CCPA 1963). The ultimate legal conclusion of obviousness must be based on facts or records, not the Examiner's unsupported allegation that a particular structural modification "would have [been] selected" and is thus obvious.

Second, Applicants have added to claim 3 the requirement that the shaft be from 35 to 47 inches, a standard shaft length. A child's shaft would not be of the standard adult length. Therefore, a children's shaft designed for smaller hands, would not be of a length meeting the Applicant's claimed requirements. In this regard, absent the understanding of the effect of the butt diameter on flex of the golf shaft, a understanding which is lacking in the prior art, the skilled artisan would not devise a standard length shaft meeting Applicant's claimed limitations. More particularly, a narrow diameter butt shaft is problematic with respect to grip manufacturers who would be required to utilize more rubber and devise new molds for an unconventional shaft. Accordingly, in the absence of Applicant's knowledge on shaft flex, the motivation in the art is against designing a shaft having a butt end diameter as currently claimed. In addition, it is equally likely a child's shaft would not have a diameter as wide as .460 inches. O

In view of the above, Applicants submit that this application is in condition for allowance and such action is respectfully requested.

If any fees are due in conjunction with the filing of this Response, Applicants authorize deduction of those fees from Deposit Account No. 06-0308.

Respectfully submitted,  
FAY, SHARPE, BEALL, FAGAN  
MINNICH & MCKEE

  
\_\_\_\_\_  
Scott A. McCollister  
Reg. No. 33,961  
1100 Superior Avenue,  
Suite 700  
Cleveland, Ohio 44114-2518  
(216) 861-5582

CERTIFICATE OF MAILING

I hereby certify that this AMENDMENT UNDER 37 CFR §1.115 is being deposited with the United States Postal Service as first class mail in the envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on this August 27, 1998.

  
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GEORGE B. GEORGE